

REMARKS

In response to the Office Action dated July 25, 2006, Applicant respectfully requests reconsideration based on the above claim amendments and the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Upon entry of this response, claims 1-2, 4-5, 7-8, 10, 12-23, 25, 27-30, 33-34, 36, 38-40, 42-43, and 45-58 are pending in the application. In this response, claims 47-58 have been added, and claims 6, 11, 24, 31, 37, and 44 have been cancelled without prejudice or disclaimer.

1. Rejection of Claims 1-2, 4-8, 10-25, 27-31, 36-40, and 42-46 under 35 U.S.C. §103

Claims 1-2, 4-8, 10-25, 27-31, 36-40, and 42-46 have been rejected under §103(a) as allegedly obvious over *Klein* (5,479,411) in view of *Sit et al.* (6,349,336) and *Cooper et al.* (6,052,442) and *Seshadri* (6,249,808). Applicant respectfully submits that the rejection of claims 6, 11, 24, 31, 37, and 44 is rendered moot by claim cancellation. Applicant respectfully traverses the rejection of claims 1-2, 4-8, 10-23, 25, 27-31, and 36. Applicant respectfully submits that the rejection of claims 37-40 is overcome by claim amendments made herein. It is well established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. See, e.g., *In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

a. Claims 1, 7, and 13

Applicant respectfully submits that claim 1 is allowable for at least the reason that the proposed combination does not disclose, teach, or suggest at least the feature of “a process to notify the subscriber of the voicemail message indicating the presence of the new email message.” Claim 7 is allowable for at least the reason that the proposed combination does not disclose, teach, or suggest at least the feature of “notifying the subscriber of the voicemail message indicating the presence of the new email

message.” Claim 13 is allowable for at least the reason that the proposed combination does not disclose, teach, or suggest at least the feature of “second process further configured to...notify that subscriber of the voicemail message indicating the presence of the new email message.”

Neither *Sit et al.* nor *Cooper et al.* discloses notifying a subscriber of a voicemail message indicating the presence of a new e-mail message. *Klein* discloses that:

[C]omputer 1002 examines an e-mail message received for that user to determine which segments thereof can be converted into a voice message via text-to-speech function and which segments thereof are not amenable to this conversion. The convertible segments are converted into a voice message, and the nonconvertible segments are converted into a fax message.
(Col. 4, lines 40-45.)

[C]omputer 1002 transfers the voice file 500 and fax file 510 of the integrated voice-and-fax message 600 over LAN 1001 to message system 1000...Controller 10 of system 1000 treats LAN 1001 as a caller and stores the message 600 in the manner shown in FIG. 2. Then, upon demand, controller 10 presents message 600 as an integrated voice-and-fax message to the recipient user, also in the manner shown in FIG. 2.
(Col. 6, lines 10-20.)

Applicant notes that *Klein* describes that the user must specifically call into the message system 1000 in order to retrieve integrated voice-and-fax messages, and even to discover that a new integrated voice-and-fax message is available. Thus, the message system 1000 does not “notify the subscriber of the voicemail message indicating the presence of the new email message” as recited in claims 1, 7, and 13. For the same reason, message system 1000 does not correspond to a “second process further configured to...notify that subscriber of the voicemail message indicating the presence of the new email message.”

Seshadri discloses that:

In step 302 an email message addressed to wireless communication device 170 is received and stored at message server 130...In step 306 the received message is split in accordance with the subscriber preferences determined in step 304. The message is split by retrieving the message from storage 136 of the message server 130

and storing the message in storage 136 as two portions, a text portion and a voice portion.
(Col. 4, lines 20-25 and 55-65.)

In step 308 the text portion of the message is transmitted to the wireless communication device to be displayed on display 216 of wireless communication device 170. In step 310 the message server 130 waits for the user of wireless communication device 170 to request the voice portion of the message. Upon receipt of such a request, the message server 140 retrieves the voice portion of the message from storage 136 and converts it to speech...In step 314 the message server 130 transmits the voice portion of the message to the wireless communication device 170.
(Col. 4, line 65 to Col. 5, line 15.)

Applicant notes that *Seshadri* describes that the user must specifically request the message server 130 to transmit the voice portion of the received message. Thus, the message server 130 does not “notify the subscriber of the voicemail message indicating the presence of the new email message” as recited in claims 1, 7, and 13. For the same reason, message server 130 does not correspond to a “second process further configured to...notify that subscriber of the voicemail message indicating the presence of the new email message.”

Thus, the proposed combination does not teach at least the above-described features recited in amended claims 1, 7, and 13, and the claims are not obvious under the proposed combination. Applicant respectfully requests that the rejection be withdrawn.

b. Claims 22, 28, 34, and 39

Applicant respectfully submit that claim 22 is allowable for at least the reason that the proposed combination does not disclose, teach, or suggest at least the feature of “notifying, in the server, the subscriber of the new email message using the converted header information, wherein the email notification is separate from and in addition to sending the converted header to the voicemail system.” Claim 28 is allowable for at least the reason that the proposed combination does not disclose, teach, or suggest at least the feature of “notifying the subscriber of the new email message using the converted header information, wherein the email notification is separate from and in

addition to sending the converted header to the voicemail system.” Claim 34 is allowable for at least the reason that the proposed combination does not disclose, teach, or suggest at least the feature of “a process for automatically notifying the subscriber of the email message separate from and in addition to leaving the voicemail message.” Claim 39 is allowable for at least the reason that the proposed combination does not disclose, teach, or suggest at least the feature of “automatically notifying, by the email notification server, the subscriber of the new email message identified in response to the polling, wherein the email notification is separate from and in addition to sending the voicemail message.”

Neither *Sit et al.* nor *Cooper et al.* discloses notifying the subscriber of a new email message using converted header information. *Klein* discloses that:

[C]omputer 1002 examines an e-mail message received for that user to determine which segments thereof can be converted into a voice message via text-to-speech function and which segments thereof are not amenable to this conversion. The convertible segments are converted into a voice message, and the nonconvertible segments are converted into a fax message.
(Col. 4, lines 40-45.)

[C]omputer 1002 transfers the voice file 500 and fax file 510 of the integrated voice-and-fax message 600 over LAN 1001 to message system 1000...Controller 10 of system 1000 treats LAN 1001 as a caller and stores the message 600 in the manner shown in FIG. 2. Then, upon demand, controller 10 presents message 600 as an integrated voice-and-fax message to the recipient user, also in the manner shown in FIG. 2.
(Col. 6, lines 10-20.)

Applicant notes that *Klein* describes that the user must specifically call into the message system 1000 in order to retrieve integrated voice-and-fax messages, and even to discover that a new integrated voice-and-fax message is available. Thus, the message system 1000 does not “notify the subscriber of the new email message using the converted header information,” as recited in claims 22 and 28. Similarly, the message system 1000 is not “a process for automatically notifying the subscriber of the email message separate from and in addition to leaving the voicemail message,” as recited in claim 34. Similarly, the message system 1000 does not disclose

“automatically notifying, by the email notification server, the subscriber of the new email message identified in response to the polling, wherein the email notification is separate from and in addition to sending the voicemail message” as recited in claim 39.

Furthermore, even assuming *arguendo* that a user calling in to check for new voice messages corresponds to a notification of a new voice message, then there is no distinction between the notification of the new voicemail message and the message itself. In that case, the presence of a new voice message in system 1000 acts a notification of a new voice message. In contrast, claims 22, 28, 34, and 39 recite that the “email notification is separate from and in addition to sending the converted header to the voicemail system.” Claims 34 and 39 recite that the notification is “separate from and in addition to leaving the voicemail message.”

Seshadri discloses that:

In step 302 an email message addressed to wireless communication device 170 is received and stored at message server 130...In step 306 the received message is split in accordance with the subscriber preferences determined in step 304. The message is split by retrieving the message from storage 136 of the message server 130 and storing the message in storage 136 as two portions, a text portion and a voice portion.
(Col. 4, lines 20-25 and 55-65.)

In step 308 the text portion of the message is transmitted to the wireless communication device to be displayed on display 216 of wireless communication device 170. In step 310 the message server 130 waits for the user of wireless communication device 170 to request the voice portion of the message. Upon receipt of such a request, the message server 140 retrieves the voice portion of the message from storage 136 and converts it to speech...In step 314 the message server 130 transmits the voice portion of the message to the wireless communication device 170.
(Col. 4, line 65 to Col. 5, line 15.)

Applicant notes that *Seshadri* describes that the user must specifically request the message server 130 to transmit the voice portion of the received message. Thus, the message server 130 does not “notify the subscriber of the new email message using the converted header information,” as recited in claims 22, 28, 34, and 39. In addition, for the same reason as argued above in connection with *Klein*, a user requesting the

voice portion of a received email message cannot serve as a notification of that same message which is “separate from and in addition to sending the converted header to the voicemail system” as recited in claims 22, 28, 34, and 39, and cannot serve as a notification which is “separate from and in addition to leaving the voicemail message” as recited in claims 34 and 39.

Thus, the proposed combination does not teach at least the above-described features recited in amended claims 22, 28, 34, and 39, and the claims are not obvious under the proposed combination. Applicant respectfully requests that the rejection be withdrawn.

c. Claims 6, 11, 24, 31, 37, and 44

Claims 6, 11, 24, 31, 37, and 44 are cancelled without prejudice, waiver, or disclaimer, and the rejection of these claims is therefore rendered moot. Applicant takes this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicant reserves the right to pursue the subject matter of these cancelled claims in a continuing application, if Applicant so chooses, and does not intend to dedicate any of the cancelled subject matter to the public. Applicant expressly reserves the right to present cancelled claims 6, 11, 24, 31, 37, and 44, or variants thereof, in continuing applications to be filed subsequent to the present application.

d. Claims 2, 4-5, 8, 10, 12, 14-21, 23, 25, 27, 29-30, 33, 36-40, 42-43, and 45-46

For at least the reasons discussed above, claims 1, 7, 13, 22, and 28 are allowable over the combined teachings of *Klein*, *Cooper et al.*, of *Sit et al.*, and *Seshadri*. Applicant respectfully submits that claims 2, 4-5, 8, 10, 12, 14-21, 23, 25, 27, 29-30, 33, 36-40, 42-43, and 45-46 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant respectfully requests that the rejection of claims 2, 4-5, 8, 10, 12, 14-21, 23, 25, 27, 29-30, 33, 36-40, 42-43, and 45-46 be withdrawn.

2. Newly Added Claims

At least one example, among others, of the subject matter included in new claims 47-58 is discussed in various portions of the instant application. One example, among others, of such discussion is: p. 2, lines 5-15; p. 3, lines 10-15; p. 6, lines 5-20.

Applicant submits that new dependent claims are allowable over the cited references for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant requests the Examiner to enter and allow the above new claims.

CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 1-2, 4-5, 7-8, 10, 12-23, 25, 27-30, 33-34, 36, 38-40, 42-43, and 45-58 be allowed to issue. Any statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

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